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APPLICATION NO.	CL. FEE CODE	INVENTOR NAME (S)	ATTORNEY'S DOCKET NO.	COMPLEMENTARY NO.
06/071945	1.1.1.2003	Carol W. Berglund	18870-876-S	8-004

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EXAMINER

WOLFE, JOSEPH E

ARGUMENT

PAPER NUMBER

1632

DATE MAILED 07/03/2003

Please find below and or attached an Office communication concerning this application or proceeding.

# Office Action Summary

App. No. 10 074 945

App. No. 10 074 945

Readhead et al.

Examiner

Joseph Wortach

Art. Unit

1632



The MAILING DATE of this communication appears on the cover sheet with the correspondence address

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 7 MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION.

Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after 18 months from the mailing date of this communication.

If the period for reply specified above exceeds 11 months, 29 days, a reply within the statutory maximum of 11 months, 29 days will be considered timely.

If the period for reply as specified above, the maximum statutory period will apply, and will expire 18 months from the mailing date of this communication, unless a reply within the set or extended period for reply will, by statute, cause the application to become a PCT Application under 37 CFR 1.55.

Any reply received by the Office later than the 18 months after the mailing date of this communication, except timely filed reply, may require any claimed patent for readjustment under 37 CFR 1.136(b).

## Status

- 1a) ☒ Responsive to communication(s) filed on Nov 12, 2001
- 2a) This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4a) ☒ Claims 1-3b are pending in the application.
- 4a) Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ are allowed.
- 6) Claim(s) \_\_\_\_\_ are rejected.
- 7) Claim(s) \_\_\_\_\_ are objected to.
- 8) ☒ Claims 1-3b are subject to restriction and/or election requirement.

## Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some\* c) None of:
- Certified copies of the priority documents have been received.
  - Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- |  |  |
|--|--|
| 1. Notice of Patenting (Form PTO-912)                          | 4. Interview Summary (PTO 413, Paper No. 5)        |
| 2. Notice of Draftsperson's Patent Drawing Review (PTO 943)    | 5. Notice of Informal Patent Application (PTO 152) |
| 3. Information Disclosure Statement(s) (PTO 1449, Paper No. 5) | 6. Other   |

Art Unit: 1632

### **DETAILED ACTION**

This application is a divisional of application 09 191,920, filed November 13, 1998, now patent 6,316,692, which claims benefit to provisional application 60 065,825, filed November 14, 1997.

The preliminary amendment filed November 12, 2001, paper number 2, has been received and entered. The specification has been amended. Claims 1-134 have been canceled. Claim 135 has been added. Claim 135 is pending and currently under examination.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

This application contains claims directed to the following patentably distinct species of the claimed invention: the method is drawn to the delivery of a polynucleotide to different types of germ cells as set forth in claim 135. Applicants must elect one specific germ cell type selected from the group consisting of: (1) a spermatogonial stem cell, (2) a type B spermatogonia, (3) a primary spermatocyte, (4) a preleptotene spermatocyte, (5) leptotene spermatocyte, (6) zygotene spermatocyte, (7) pachytene spermatocyte, (8) secondary spermatocyte, (9) spermatid, and (10) spermatozoa.

Art Unit: 1632

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, the single claim is generic to all the species of cell types.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Dianiece Jacobs whose telephone number is (703) 308-2141.

The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach